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EXAMINER

KAHELIN, MICHAEL WILLIAM

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/531,359
Filing Date: April 13, 2005
Appellant(s): HANSEN ET AL.

W. Brinton Yorks, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/17/2009 appealing from the Office action mailed 8/6/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,700,281	Brewer et al.	12-1997
WO 01/56652	Freeman	8-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by Brewer et al. (US 5,700,281, hereinafter “Brewer”).

In regards to claims 23 and 24, Brewer discloses prompting the user with a first electrode pad prompt (col. 8, lines 54-67), detecting prior to pad placement that the pad is being handled (Fig. 10), prompting the operator to conduct a pad placement action (col. 8, line 60), sensing that the operator has conducted the prompted action (col. 8, lines 54-67), and receiving an ECG signal following the placement (col. 8, line 60). Please note that Brewer’s invention “knows what has been done and what needs to be done,” and issues the voice prompts accordingly (col. 8, lines 57-58). Further, the pad correction prompt is to remove a pad liner (“please pull electrodes apart” indicates that the first electrode pad must be separated from the second electrode liner and vice versa), and must not be touching each other (“pull electrodes apart”; col. 8, lines 59-60). The electrodes are only determined to be in proper contact with the subject if the impedance is that shown in element 414 of Figure 10 and the algorithm has reached the

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proper progression. As such, each of the other "stages" of Brewer's invention senses that the pads are not in proper contact with the subject.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewer. Brewer discloses the essential features of the claimed invention except for a pad correction prompt that the pads must not touch clothing, or repeating the prompts until the operator has conducted the prompted action. However, it is well known in the defibrillator art to provide a pad correction prompt that the pads must not touch clothing to provide the predictable result of ensuring that the electrodes have intimate and

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effective contact with the skin, and repeating the prompts until the operator has conducted the prompted action to provide the predictable result of indicating to the user when the directed action has been suitably performed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brewer's invention by providing a pad correction prompt that the pads must not touch clothing to provide the predictable result of ensuring that the electrodes have intimate and effective contact with the skin, and repeating the prompts until the operator has conducted the prompted action to provide the predictable result of indicating to the user when the directed action has been suitably performed.

(10) Response to Argument

As a threshold matter, it is noted that the Appeal Brief filed 12/17/2009 contains minor formatting issues including large spaces between words and characters within the same word. Resubmission of the Appeal Brief in a more readable format would improve clarity.

A. Whether Claims 23 and 24 were correctly rejected under 35 U.S.C. § 102(b) as being anticipated by US Pat. 5,700,281 (Brewer et al.)

Appellant argued that Brewer fails to disclose the claimed invention because Brewer's disclosure of instructing the user to "please pull electrodes apart" is not a pad correction prompt to remove a pad liner. Appellant further argued that Brewer's disclosure of separating the pads from each other is not an instruction to remove the liners from the two pads, and that the prompt is issued in the normal sequence of prompting and not when a problem has arisen. However, the examiner respectfully

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maintains of rejection based on the independently sufficient grounds that (I) “prompts” as claimed can reasonably be construed to have a subjective quality, and (II) Brewer explicitly discloses the claimed prompts anyway. Regarding ground (I), a prompt (such as a “pad correction prompt”) reasonably includes the subjective interpretation that a user would give that prompt. For instance, Brewer’s prompt to “please check electrodes” can reasonably be considered a prompt to not merely look at the electrodes and look away (*i.e.*, “check”), but to ensure that the electrodes are in conductive contact with the patient -- the rescue personnel recognizing this as a prompt to remove pad liners, to make sure that the pads should not touch each other, to remove clothing, to place the electrodes in contact with a patient, or to remove any other obstruction. In other words, the claimed “prompt” (*e.g.*, a pad correction prompt to remove a pad liner) could be as simple as a red light or a buzzer that indicates incorrect placement and/or that indicates the liners should be removed. The claims do not state that the prompt is a verbal prompt to remove the pad liners. Regardless of this interpretation of “prompt,” Brewer explicitly discloses “issuing a pad correction prompt to remove a pad liner” at column 8, line 59 (“please pull electrodes apart”). Each electrode has its own liner (col. 5, lines 30-31), and thus pulling the two electrodes apart includes removing the *first* electrode from the *second* liner and the *second* electrode from the *first* liner. The claim does not recite from what the pad liner is removed. This position was set forth in paragraph 3 of the final office action. Furthermore, the pads are not “correctly placed” until stage 4 of Brewer's flowchart of Figure 10. As such, each prompt leading up to the final correct placement is a “pad correction prompt” because these prompt the user to

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complete the steps necessary to correctly place the pads. Brewer's algorithm senses whether the pads are in proper contact with the subject by virtue of the impedance measurement (e.g., steps 402, 406, 410, 414, and 418), and issues prompts accordingly.

Appellant further argued, in regards to claim 24, that Brewer's prompt to "please pull electrodes apart" is not a pad correction prompt because there is no problem to correct at the time it is issued and the prompt is not issued after sensing proper pad placement on the subject. The examiner respectfully disagrees. As set forth in the final office action of 8/6/2009, Brewer's algorithm "knows what had been done and what needs to be done," and issues voice prompts accordingly (col. 8, lines 57-58). For instance, at step 400, Brewer's algorithm recognizes that the lid of the device has been opened, but that the electrodes are not yet suitably placed on the subject (as this requires an impedance of 25-200 ohms, per step 414). Brewer's algorithm then issues the prompt "please open the electrode package" at step 402 (col. 8, line 58 and col. 9, lines 17-22), and then measures the impedance again at step 406 to determine "whether the pads are in proper contact with the subject." If the pads are still not in proper contact (as determined by an impedance of 25-200 ohms, per step 414), a pad correction prompt of "please pull electrodes apart" is issued at step 406 (col. 8, line 59 and col. 9, lines 23 to 31).

B. Whether Claims 25-28 were correctly rejected under 35 U.S.C. § 103(a) as being unpatentable over Brewer et al.

Appellant argued that neither Brewer nor Freeman (WO 01/56652 -- cited in the office action of 2/24/2009 as one of many teachings of providing prompts that electrode pads must not touch clothing and repeating prompts until conditions are satisfied) disclose a prompt that pads must not touch clothing. However, the examiner respectfully maintains that Freeman's steps 122f-h of checking electrode impedance and issuing the prompt to "[o]pen the person's shirt or blouse and attach the adhesive pads as shown in the diagram" is a simple substitution for Brewer's pad correction prompts and this prompt is a "pad correction prompt that the pads must not touch clothing" because the diagram to which Freeman refers (Fig. 2) depicts this concept. This figure shows several aspects of the placement configuration, including a nude torso in which the pads do not touch clothing. Furthermore, a user would recognize the instruction to "[o]pen the person's shirt or blouse" to be a prompt that the pads should not be placed in contact with the shirt or blouse. Appellant recognizes at page 14 of the appeal brief that this is "an instruction to bare the patient's torso so the pads can be attached to the bare chest." This is within the scope of a "prompt that the pads must not touch clothing," because "a bare chest" necessarily indicates that no clothing is present and the "prompts" need not be verbatim, quoted statements of what is recited in the claims, but what a user would recognize as a "prompt" to do something. The examiner maintains that Freeman's prompt to place the electrodes as shown is a prompt that the pads must not touch clothing because that is how the pads are depicted in the diagram, and that this prompt would have been a simple substitution for Brewer's pad placement prompts.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Michael Kahelin/

Examiner, Art Unit 3762

Conferees:

/George R Evanisko/

Primary Examiner, Art Unit 3762

/Michael J Milano/

Primary Examiner